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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Kimble	)	Art Unit: 2623
	)	
Serial No.: 09/835,300	)	Examiner: Huynh
	)	
Filed: April 13, 2001	)	50P3984.01
	)	
For: MEDIA ON DEMAND SYSTEM AND METHOD	)	January 26, 2007
	)	750 B STREET, Suite 3120
	)	San Diego, CA 92101
	)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

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(1) **Real Party in Interest**

The real parties in interest are Sony Corp. and Sony Electronics, Inc.

(2) **Related Appeals/Interferences**

An appeal has been filed in 09/775,692 which may be related.

(3) **Status of Claims**

Claims 1-113 are canceled and Claims 114-117 are pending and twice rejected, which rejections are the subject of this appeal.

(4) **Status of Amendments**

No amendments are outstanding.

(5) **Summary of Claimed Subject Matter**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 114 sets forth a method for providing video-on-demand that includes using a TV system (reference numeral 24 and related STB 22, figure 1; page 10, line 6) to present to a user's Web browser a list of links. Each link corresponds to a respective piece of television video-on-demand (figure 6A; page 19, last

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two lines through page 20). The method includes receiving a selection of a link and in response to the selection, sending a protocol file to the TV system, page 9, lines 4-7. The protocol file includes a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer (figures 6B and 6C; page 21, first two lines). Also, the method includes causing a channel tuner of the TV system to tune to the TV channel corresponding to the video-on-demand associated with the selection (page 20, lines 11-15).

Claim 117 recites system for providing video on demand that includes a user's TV system in turn including a set-top box (STB) (22, figure 1, page 10, lines 1-10) and a display (24, id.). A Web browser presents images on the display. The system also includes a television head end (520, figure 10; page 8, lines 13-18). According to Claim 117, the set-top box includes means for presenting a list of links, with each link corresponding to a respective piece of television video-on-demand (figure 6A; page 19, last two lines through page 20), means (544, figure 11; page 24, lines 13-16) for receiving a selection of a link, and means for displaying a video program on the display in accordance with a protocol file (page 9, lines 4-7) including a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer (page 20, lines 11-15). Means are provided for causing a channel tuner of the TV system to tune to the TV channel corresponding to the video-on-demand associated with the selection, id.

(6) Ground of Rejection to be Reviewed on Appeal

Claims 114-117 have been rejected under 35 U.S.C. §103 as being unpatentable over Fries et al., USPN 6,317,885 in view of Schumacher et al., USPN 6,757,907 (used as a teaching of video-

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on-demand) and Zigmond et al., USPN 7,076,792 (used as a teaching of a protocol file including a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer).

(7) **Argument**

As an initial matter, it is noted that the SPE has signed out the Office Action, meaning he has reviewed and agreed with the examiner after having already considered the gravamen of the arguments below. Accordingly, either an Allowance or an Examiner's Answer, but not a reopening of prosecution, will be expected in response to this appeal.

**The Obviousness Rejection of the Independent Claims**

As readily admitted in the Office Action, Fries et al. fails to disclose a protocol file that includes a TV channel of a selected link and a size and location of a video layer within a markup language layer, resorting to Zigmond et al., col. 2, lines 4-22, col. 3, line 3-col. 4, line 37, col. 5, lines 43-47, and col. 7, lines 45-62.

The problem with the rejection is that Zigmond et al. does not teach what the examiner alleges it does. Specifically, col. 2, lines 4-22 merely teach that HTML tags identifying a *document element* such as a heading or paragraph (i.e., text) can indicate, among other things, "color, size, position, and the size and style of fonts." A HTML page can then be rendered using the tags. Nothing is mentioned in this portion of col. 2 about video, much less the specific information recited in the independent claims.

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Columns 3 and 4 appear to teach that a partially transparent text or graphic page can be overlaid in its entirety on an entire background video image page. There appears to be no mention of any portion within a page being dedicated to video, much less then is there any need to supply a protocol file that includes a TV channel of a selected link and a size and location of a video layer within a markup language layer as required by the independent claims.

The relied-upon portion of col. 5 teaches that a tag can include a URL to a TV resource, including "channel number, image width, image height, "full screen" (i.e., ignore width and height), input source, z position, and image transparency." What these attributes appear to refer to is that the standard TV image aspect ratio can be reduced as appropriate for the display or not, but not that a particular place in a markup language page is designated by the "width" and "height", which are nowhere said to be in any relationship with a coordinate system. The gap between the claims and this part of Zigmond et al. thus is laid bare. The relied-upon portion of col. 7 appears to relate only to displaying a TV URI in response to clicking on a link.

Accordingly, even if the references were to be combined, the independent claims would not result. First, in none of the relied-upon portions of Zigmond et al. is it taught that a protocol file is sent to a TV system. Second, whatever the examiner has in mind as to what in Zigmond et al. is a "protocol file", as discussed above the relied-upon portions simply do not teach anything about a *location* of a video layer within a markup language layer. It appears that the rejections should be withdrawn.

Additionally, Applicant would like to offer the following comments about Fries et al. The only part of Fries et al. that appears to specifically mention links corresponding to a video program, col. 18, lines 6-22, nowhere mentions that the video program is presented within a portion of a markup layer, much less in

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accordance with the size and location defined by a protocol file, much less still a protocol file that is downloaded in response to selection of a link as recited in the independent claims.

The Office Action lists a number of locations in Fries et al. that allegedly teach a protocol file "that contains meta-data and PSI data for displaying the video program corresponding to the selected link." That is incorrect, as a rigorous reading of Fries et al. demonstrates. In each section cited by the examiner to discuss metadata and PSI data, the section has nothing to do with the video link feature mentioned briefly in column 18, but only with conventional web page presentation that forms a large part of the set-top box browser invention of Fries et al. With more specificity:

Col. 2, lines 30-38 discuss injecting video information into TV programming, with the video information representing Web pages, not television VOD as claimed. The meta-data discussed at line 33 thus relates to displaying web pages and only web pages, without any video layers within them. Certainly, no meta-data is said in this section to be downloaded in response to the selection of a link as recited in the independent claims.

Indeed, col. 7, lines 7-52 and col. 8, line 50-col. 11, line 37 make Applicant's point in this regard, because in these sections Fries et al. teaches that the meta-data is read from an API in the STB that evidently is not downloaded "in response to selection of a link", much less a link to a television VOD, but that already resides there. And nowhere do these sections contemplate that anything, much less a "protocol file", indicates a size and location of a video layer in a markup language layer.

Moreover, Applicant's point that the relied-upon meta-data and PSI data are applied by Fries et al. only to conventional web pages is bolstered by col. 19, lines 30-63 and col. 22, line 61-col. 23, line 15 as follows. Col. 19 is explicitly directed to "page Images", line 15; the PSI data is explicitly said to facilitate display of

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page images, as opposed to television VOD, lines 35-40. Indeed, col. 22, lines 60-65 (titled "Meta-Data") clarify that the meta-data is directed to web page display, and nowhere mentions a video frame within a markup language frame much less defining a size and location of the video frame. Tellingly, the only part of Fries et al. that has been relied on as teaching links as best discerned by Applicant, col. 18, lines 6-23, nowhere mentions protocol files, meta-data, or PSI data, much less a protocol file that contains size and location information pertaining to television VOD layers, much less still one that is downloaded in response to selection of a link to a channel in contrast to the independent claims. Thus, Fries et al. is devoid of any fair suggestion to combine it with Zigmond et al. and for that matter Schumacher et al. in the way proposed in the rejection.

It appears to be the examiner's contention that "the protocol file is inherently sent to a TV system". This appears to be incorrect. To the extent that the meta-data and PSI data have been relied on as the "protocol file", it is simply not the case that they contain information on anything other than the web pages that are injected into the broadcast stream, for reasons discussed above, and there is thus no apparent reason to send them to a TV. Accordingly, since a missing element must "necessarily" be in the prior art to support inherency, MPEP §2112, and the relied-upon "protocol file" has use outside a TV system, it does not necessarily have to be sent to a TV system.

The latest Office Action, which has been approved by a SPE, responds to the above lucid observations with some difficult to understand and seemingly irrelevant or plain wrong contentions. As best understood the Appellant, the examiner appears to allege that because part of Appellant's argument related to Fries et al. does not appear *in haec verba* in Claim 114, Fries et al. meets the limitation being argued. However, the allegation belies itself, because it alleges that Fries et al. sends metadata and PSI data (used as the claimed

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"protocol file") without addressing *what is in fact in Claim 114*, namely, that the protocol file includes (1) a TV channel corresponding to the video-on-demand associated with the selection and (2) a size and (3) location of a video layer *within a markup language layer* - indeed, as argued by Appellant. At least these latter two limitations have been ignored in the latest response, underscoring the bankruptcy of the rejection.

The next contention in the latest SPE-approved Office Action, as best understood in its awkward form, is that Zigmond et al. has not been used for a teaching of a protocol file being sent to a TV (as argued in a single phrase above as part of a much longer analysis) but rather for a teaching of a protocol file including a TV channel of a link, and a size and location of a video layer within a markup layer, repeating the citations to Zigmond et al. However, Appellant indeed has analyzed and eviscerated these citations above, with the latest response not attempting to offer a rebuttal. Thus, the latest response brushes off Appellant's single phrase assertion that Zigmond et al. fails to teach that a protocol file is sent to a TV system while ignoring the overwhelming weight of Appellant's argument concerning Zigmond et al, namely, that it fails to teach anything about a *location* of a video layer within a markup language layer.

Next, the latest Office Action persists in failing to grasp that the relied-upon metadata and PSI data for the HTML pages are isolated in Fries et al. from the relied-upon tuning of the set-top box to a video channel in column 18. Accordingly, the allegation that "the metadata and PSI data are used for video link feature (sic) such as link (sic) to tunes (sic) to a video channel, or link to an image for display on the television" is plain wrong. That is not what column 18 of Fries et al. teaches.

Column 18 teaches that "for any page, it is possible to include a link" to a video channel, lines 6 and 7. The link itself is not taught to be in the relied-upon metadata, but it indeed is the thing that is selected to choose a channel, lines 10-15. In the event that the selected program is in the future, Fries et al. prompts the

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user to enter a viewing time and pay for a pay-per-view event, lines 15-22. "To accomplish such actions", i.e., to enter a viewing time and pay for a pay-per-view event, lines 23 *et seq.* provide access to functions in the programming guide in part by using metadata to indicate that a form query string should be submitted to the guide, thus allowing "page image authors to access guide emulation". Accordingly, to the extent that the "metadata" in column 18 is related at all to the earlier metadata relied on in the rejections (which is not clear), it is not used, contrary to the allegation in the most recent Office Action, to cause a channel to be tuned to but rather to permit a viewer to enter a future viewing time and possibly to pay for certain programs.

The Office Action next dismisses Appellant's assertion that Fries et al. fails to teach video on demand by agreeing with it, noting that Schumacher et al. has been used for the missing VOD teaching without attempting to rebut Appellant's reasons why there is no fair suggestion to combine the references as proposed.

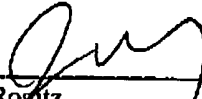
The last contention in the latest SPE-approved Office Action near the bottom of page 4 is nearly incomprehensible but it appears to be the examiner's contention that a TV system can encompass pretty much the entire world since the claims do not define a location for the system. Absent evidence of record that the skilled artisan would accord such a nonsensical construction to the claims under MPEP §2111.01, the contention is without merit.

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#### APPENDIX A - APPEALED CLAIMS

114. A method for providing video-on-demand, comprising:

using a TV system to present to a user's Web browser a list of links, each link corresponding to a respective piece of television video-on-demand;

receiving a selection of a link;

in response to the selection, sending a protocol file to the TV system, the protocol file including a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer; and

causing a channel tuner of the TV system to tune to the TV channel corresponding to the video-on-demand associated with the selection.

115. The method of Claim 114, wherein the TV system includes a set-top box (STB), the STB presenting to the user's Web browser the list of links.

116. The method of Claim 114, wherein a set-top box provides an Internet layer and a video layer to the user's web browser, the browser being directed to render a portion of the Internet layer transparent to establish a transparent Internet portion, the transparent Internet portion having a size and screen location specified in the protocol file, the video layer being presented in the transparent Internet portion.

117. A system for providing video on demand, comprising:

a user's TV system including a set-top box (STB) and a display;

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a Web browser presenting images on the display; and

a television head end;

the set-top box including:

means for presenting a list of links, each link corresponding to a respective piece of television video-on-demand;

means for receiving a selection of a link;

means for displaying a video program on the display in accordance with a protocol file including a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer; and

means for causing a channel tuner of the TV system to tune to the TV channel corresponding to the video-on-demand associated with the selection.

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**APPENDIX B - EVIDENCE**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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**APPENDIX C - RELATED PROCEEDINGS**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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